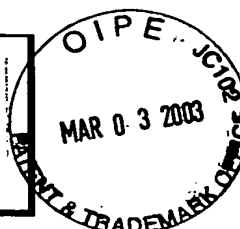


Response under 37 C.F.R. 1.106  
- Expedited Examining Procedure -  
Examining Group 1752



BOX AF  
Docket 81749AJA

AF/1700

Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Ward B. Bowen, Jr., et al

Group Art Unit: 1752

Examiner: Amanda C. Walke

PHOTOGRAPHIC ELEMENT WITH  
LIGHT SENSITIVE LAYER  
COMPRISING BLEND OF HIGH  
CHLORIDE EMULSION GRAINS  
DOPED WITH DIFFERENT METAL  
COMPLEXES

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to Commissioner for Patents, Washington, D.C. 20231.

Valerie J. Richardson  
Date

February 25, 2003

Serial No. US 09/919,239

Filed 31 July 2001

Commissioner for Patents  
Washington, D.C. 20231

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TC 1700

Transmitted herewith is an amendment in the above-identified application:

- ☒ No additional fee is required.  
☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL		MINUS	20	0	X 18	\$ 0
INDEP		MINUS	3	0	X 84	\$ 0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					+ 280	\$ 0
					<b>TOTAL</b>	<b>\$ 0</b>

\* The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

☐ Please charge my Eastman Kodak Company Deposit Account No. 05-0225 in the amount of \$ 0.

A duplicate copy of this sheet is enclosed

☒ The Commissioner is hereby authorized to charge payment of  
the following fees associated with this communication or credit any overpayment to Eastman Kodak  
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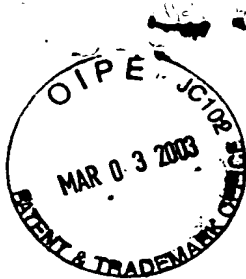
☒ Any additional filing fees required under 37 CFR 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

(For Extensions of Time and other Petitions to the Assistant Commissioner)

Andrew J. Anderson/vjr  
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Registration No. 33,564



**Response under 37 C.F.R. 1.116  
- Expedited Examining Procedure -  
Examining Group 1752**

**BOX AF  
81749AJA**

**Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Ward B. Bowen, Jr., et al

Photographic Element With Light  
Sensitive Layer Comprising Blend Of  
High Chloride Emulsion Grains Doped  
With Different Metal Complexes

Serial No. US 09/919,239

Filed 31 July 2001

Commissioner for Patents  
Washington, D.C. 20231

Sir:

**RESPONSE UNDER 37 CFR 1.116**

In response to the outstanding Office Action mailed December 26,  
2002, please consider the following remarks.

Claims 1-18 are finally rejected under 35 USC § 103(a) as being unpatentable over Makuta et al (5,683,853) in view of Newmiller et al (4,865,964) and McDugle et al (4,933,272) and Keevert, Jr et al (4,945,035). The Examiner repeats the rejection presented in the first Office Action, stating that given the teachings of Makuta et al that {100} silver chloride emulsions of the reference may comprise a mixed emulsion comprising two emulsions each having a different form of grains as taught by Newmiller (cited by the reference), it would have been obvious to one of ordinary skill in the art to dope one emulsion in the manner of Keevert, Jr et al to obtain an increase in sensitivity and one by method of McDugle et al to achieve a desirable increase in contrast with reasonable expectation of achieving a photographic material having increased storage stability (see column 107).

Claims 19-23 are finally rejected under 35 USC § 103(a) as being unpatentable over Makuta et al in view of Newmiller, McDugle et al, Keevert, Jr, and Research Disclosure 437013. The Examiner repeats the rejection presented in the first Office Action, stating that given the teachings of the RD that exposure doses of actinic radiation of at least 10-4 ergs/cm<sup>2</sup>, typically in the range of 10-4

Group Art Unit: 1752

Examiner: Amanda C. Walke

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to 10-3 ergs/cm<sup>2</sup> for exposure times of up to 100 microseconds, or possibly up to 10 microseconds, or even 0.5 microseconds (section XIV) are conventional in the art, and that the Makuta et al reference teaches similar exposure times, it would have been obvious to one of ordinary skill in the art to prepare the material of Makuta et al in view of Newmiller, McDugle et al, and Keevert, Jr. et al using the conventional exposure dose for the exposure method and time of Makuta et al with reasonable expectation for achieving a material have increased storage stability.

The above rejections are respectfully traversed essentially for the reasons set forth in the Response mailed December 12, 2002. The Examiner's position, at best, is based on combinations of the cited prior art being open to the possibility of independent doping of separate emulsions, but entirely fails to establish obviousness with respect to the specifically claimed invention. While it is believed Applicants' previous response fully addresses the impropriety of the stated rejections, Applicants would like to emphasize the following points believed to have been misapprehended by the Examiner.

The Examiner relies upon the reference to Newmiller at col. 64, lines 14-16 of Makuta et al. as providing "a teaching or suggestion to one of ordinary skill in the art to prepare an emulsion containing two grain fractions of different forms, each which may be doped independently". Applicant continues to believe that such interpretation of what Makuta et al. actually intended "different forms" to describe is highly questionable in view of the fact that such "different forms" reference is found only in the paragraph at col. 64 lines 5-30, which is specifically directed towards different possible crystal grain forms, rather than independent dopant possibilities, combined with the fact that the primary teaching of Newmiller itself (and only actual requirement) is directed towards blending of emulsions grains having different aspect ratios. While it is stated the blended emulsions grains of different aspect ratios may possibly have additional differences, such differences are secondary to the basic requirement of blending of grains of different aspect ratios. Further, a detailed review of Newmiller reveals that the only "example" of mixing grains having different forms (as specifically referenced at col. 64, lines 14-15 of Makuta et al.) actually disclosed in Newmiller is that of the blending of emulsions of different aspect ratios. There simply is no example of blending of independently doped emulsions which would correspond to the referenced "example of mixing grains" cited in Makuta et al. Thus, the only reasonable interpretation of what teaching of Newmiller was actually intended to be referred to at col. 64 of Makuta et al. would be only with respect to the blending of grains of different aspect ratios as actually taught by Newmiller.

Further, in any event, while it is true that the blended emulsion grains of Newmiller may be open to the possibility that they may be differentially doped, there is no explicit teaching to do so which could be reasonably interpreted as what the reference to Newmiller found in Makuta et al. was intended to suggest. To the contrary, while Newmiller states at col. 4, lines 17-19 that “one” of the blended emulsions can be doped (which is apparently the statement which the Examiner relies upon as providing any teaching regarding independent doping), such statement also clearly states that it is preferred that both of the blended emulsion be doped, which in actuality would appear to be a teaching of a general preference away from any type of independent doping for the blended emulsions of different aspect ratios. In view of such detailed review, it is clear that any possible “extension” of the specific referenced example of Newmiller to provide motivation to independently dope separate grain fractions of a blended emulsion in order to support an “obviousness” rejection of the present claimed invention would again only be arrived at in hindsight based on Applicants’ teachings. While there are additional deficiencies in the rejections as discussed in Applicants previous Response and further discussed below, reconsideration of the above rejections is strongly requested based on this point alone.

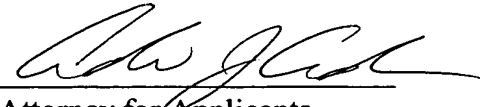
The Examiner has additionally failed to provide any explanation as to motivation found in the cited art to dope separate fractions of the emulsion grains individually specifically with the dopants of the Keevert and McDugle references. The mere possibility that individual teachings of the prior art could be combined to arrive at the claimed invention does not equate to establishing that it would have been obvious to the artisan to do so. Applicants do not contest that the combination of such references may *prima facie* suggest to one of ordinary skill to combine an additive that provided high contrast but also decreased the speed (sensitivity) with an additive that would increase the speed to even out the sensitivity as suggested by the Examiner. There is no explanation provided, however, as to why it would have been obvious to the skilled artisan to employ such dopants independently in separate grain fractions, rather than together in the same grains to obtain the combined effects, which is actually how such dopants have been used in the prior art (see, e.g., USPs 5,783,373 and 5,783,378 referenced at page 7, lines 8-14 of the specification). The Examiner apparently attempts to rely on the teaching of Newmiller as providing motivation to employ such dopants independently as opposed to in the same grains. As explained above, however, while Newmiller may be open to such possibility of independent doping, it fails to provide any specific motivation to employ the specified two types of dopants independently in separate grain fractions for any reason. To the contrary, if anything, Newmiller would appear to teach equivalent doping of the

blended emulsion grains of different aspect ratios taught therein, as it is stated at col. 4, lines 17-19 that it is preferred both emulsions are doped to form internal latent image as noted above. Clearly, it is only Applicants' teaching with respect to improved latent image keeping results that provides the motivation to independently dope separate grain fractions in accordance with the claimed invention. In particular, by specifically requiring that each of the two classes of dopants be used primarily in separate fractions of silver halide grains of an emulsion layer, Applicants have found that improved LIK performance is achieved relative to where both such dopants are employed primarily together in the same grains. Thus, the photographic emulsion layers of the elements of the present invention surprisingly enable the use of a desired combination of contrast and speed improving dopants with improved latent image keeping performance. Such results are not suggested by any conceivable combination of the cited prior art, and the claimed invention is accordingly believed to be clearly patentable thereover.

Should the Examiner elect to maintain the stated rejections, it is respectfully requested that she specifically state where any motivation may be found in the cited art to combine the references as proposed in order to arrive at the inventive teaching of improved latent image keeping performance relative to the actual prior art use of the described combination of dopants as noted above, rather than simply note that the blended emulsions of Newmiller "may" be independently doped by unspecified dopants. In the absence of the identification of any such teaching to specifically combine the references in the manner required by the present claims, withdrawal of the applied rejections is respectfully urged.

In view of the foregoing remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the Examiner is earnestly solicited. Should the Examiner believe any remaining issues may be resolved via a telephone interview, the Examiner is encouraged to contact Applicants' representative at the number below to discuss such issues.

Respectfully submitted,

  
\_\_\_\_\_  
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